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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/672,493

09/26/2003

Thomas Berger

1685-3

3531

81099

7590

12/09/2009

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EXAMINER

CUMARASEGARAN, VERN

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

12/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/672,493	<b>Applicant(s)</b> BERGER, THOMAS	
	<b>Examiner</b> VERN CUMARASEGARAN	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Allowable Subject Matter***

Claims 1-19 are considered to be allowable.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21, 22, 31, 35, 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated Cordery (US Patent No.5,781,634). Cordery shows a data base server (Fig.3 no.316) including means for comparing an uploaded address to a list of addresses stored in a data base (Fig.3 no.326 *where addresses can be uploaded via the data communications system*);

a network server coupled to said data base server (Fig.2 no.206);

a network coupled to the network server (Fig.2 nos.212 214, 216);

a remote terminal coupled to the network, said terminal including means for uploading an address to said data base server via said network and said network server (Fig.3 *where the user interface no.322 is considered to be a remote terminal*); and

a printer coupled to said terminal (Fig.3 no.304), wherein said terminal uploads an address to said data base server, said data base server compares the uploaded addresses to addresses in the data base and downloads the result of the comparison to said terminal, the results of the comparison being output by said terminal to said printer, the results including the indication of an escheat state and a probability that the indication is correct *(the functions of the terminal are not positively claimed and thus are not given patentable weight. In order for the claims to be allowable, the claims must be amended to show that the remote terminal is programmed to perform the functions recited in claim 21 such as uploading of addresses and downloading the results of the comparison).*

As to claims 23, 32, 33, 34 Cordery shows correcting uploaded address (Fig.6 no.636).

As to claims 24, 25 Cordery shows filtering non-address information (Fig.6 where in order to decrypt files, non-address information would have to be filtered. The specific type of non-address information is considered non-functional descriptive language and thus is not given patentable weight).

As to claims 29 and 30, Cordery shows indicating which addresses were corrected (Fig.7A where a list of corrected addresses is maintained).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3629

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26-28 rejected under 35 U.S.C. 103(a) as being unpatentable over  
Cordery.

As to claim 26, Cordery does not expressly show the database assigning an alternate escheat. However, examiner takes official notice that it is old and well known in the art to assign an alternate escheat. For example when an uncertain escheat is determined, an alternate escheat is often assigned.

It would have been obvious to one of ordinary skill in the art to incorporate this feature since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. (See KSR [127 S Ct. at 1739] "*The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.*").

As to claims 27 and 28, Cordery does not expressly show comparing addresses to foreign country names. However, examiner takes official notice that it is old and well known in the art to compare addresses to foreign country names if it is possible for a an escheat to be assigned to a foreign country. It would have been obvious to one of ordinary skill in the art to incorporate this feature since the claimed invention is merely a combination of old elements, and in the combination each element merely would have

Art Unit: 3629

performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERN CUMARASEGARAN whose telephone number is (571)270-3273. The examiner can normally be reached on Monday - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vern Cumarasegaran/  
Examiner, Art Unit 3629

Application/Control Number: 10/672,493

Page 6

Art Unit: 3629

/JOHN G. WEISS/

Supervisory Patent Examiner, Art Unit 3629